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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,673	07/28/2003	Hajime Sasaki	HIRA.0118	4610
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REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			EXAMINER QAYYUM, ZESHAN	
			ART UNIT 3626	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,673	Applicant(s) SASAKI ET AL.	
	Examiner ZESHAN QAYYUM	Art Unit 4137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/28/2003, 04/03/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-3 have been examined.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to claims 1-3, the claims are directed to a system and method for using system. For example claims 1-3 recite both "a medical support system" and steps of medical information control device. (i.e. receiving a request from said patient....., receiving medical information download request....., receiving a medical information reference.....". Therefore it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such claim does not sufficiently precise to provide competitor with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne (US 5867821) in view of Kitahara (US 20020087553).

7. With respect to claim 1, Ballantyne discloses: Patient terminals, medical institution terminals (i.e. clinics) (See column 6, line 47-57 and Fig 1) management server (i.e. Master library) (See column 4, line 1-3 and fig 1 and 2), Storage media (See

column 6, line 20-31 and column 4, line 29-47) and management information service (See column 7, line 16-22). Ballantyne also discloses request to upload the medical information (see column 7 line 66-67 and column 8 line 1-5) and provide the identification and authentication of individuals (See 28-46) and after authorization user can upload the medical information in the storage device. (See column 10, line 10-22). Ballantyne does not explicitly disclose the transmitting permission key, upload transmission key and authenticate the validity of permission key. Kitahara discloses transmitting permission key, upload transmission key and authenticate the validity of permission key. (See paragraph 0011). Therefore it would have been obvious to one of the ordinary skill in the art at the time of invention was made to modify Ballantyne with Kitahara by using his key access method. One of ordinary skill in the art would have been motivated to modify the reference as described above in order to provide data security.

8. In addition "an upload request step for, upon receiving a request from said patient terminal to upload said medical information of said patient managed by said medical institution in said management server, transmitting upload permission key data for uploading said medical information of said patient in said management server and a medical information upload request content to be uploaded by a patient's request to said medical institution terminal used by said requested medical institution; an upload standby step for, upon receiving said upload permission key data transmitted from said medical institution terminal, authenticating the validity of said upload permission key

data, transmitting to said medical institution terminal a permission response for transmitting said medical information to said management server, and deferring said upload; and an upload execution step for, upon receiving said medical information transmitted from said medical institution terminal, storing said medical information in said medical information storage device” is an intended use of information control device. Therefore it has been held that a claim while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

9. With respect to claim 2, Ballantyne discloses: Patient terminals, medical institution terminals (i.e. clinics) (See column 6, line 47-57 and Fig 1) management server (i.e. Master library) (See column 4, line 1-3 and fig 1 and 2), Storage media (See column 6, line 20-31 and column 4, line 29-47) and management information service (See column 7, line 16-22). Ballantyne also discloses request to download the medical information(see column 7 line 66-67 and column 8 line 1-5) and provide the identification and authentication of individuals(See 28-46) and after authorization user can download(i.e. retrieve) the medical information in the storage device.(See column 10, line 10-22). Ballantyne does not explicitly disclose the transmitting permission key, upload transmission key and authenticate the validity of permission key. Kitahara discloses transmitting permission key, upload transmission key and authenticate the

validity of permission key. (See paragraph 0011). Therefore it would have been obvious to one of the ordinary skill in the art at the time of invention was made to modify Ballantyne with Kitahara by using his key access method. One of ordinary skill in the art would have been motivated to modify the reference as described above in order to provide data security.

10. In addition “a download request step for, upon receiving a medical information download request for download and view said medical information of said patient from said medical institution terminal used by said medical institution, transmitting a content of said medical information download request to said patient terminal used by said requested patient; a download permission step for, upon receiving a permission response for downloading said medical information from said patient terminal, transmitting download permission key data which permits said medical institution to download and view said medical information to said medical institution terminal; and a download execution step for, upon receiving said download permission key data transmitted from said medical institution terminal, authenticating the validity of said download permission key data and transmitting said medical information to said medical institution terminal” is an intended use of information control device. Therefore it has been held that a claim while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

11. With respect to claim 3, Ballantyne discloses: Patient terminals, medical institution terminals (i.e. clinics) (See column 6, line 47-57 and Fig 1) management server (i.e. Master library) (See column 4, line 1-3 and fig 1 and 2), Storage media (See column 6, line 20-31 and column 4, line 29-47) and management information service (See column 7, line 16-22). Ballantyne also discloses request to access the medical information(see column 7 line 66-67 and column 8 line 1-5) and provide the identification and authentication of individuals(See 28-46) and after authorization user can download(i.e. retrieve) the medical information from the storage device.(See column 10, line 10-22). Ballantyne does not explicitly disclose the transmitting permission key, upload transmission key and authenticate the validity of permission key. Kitahara discloses transmitting permission key, upload transmission key and authenticate the validity of permission key. (See paragraph 0011). Therefore it would have been obvious to one of the ordinary skill in the art at the time of invention was made to modify Ballantyne with Kitahara by using his key access method. One of ordinary skill in the art would have been motivated to modify the reference as described above in order to provide data security.

12. The combination of Ballantyne and Kitahara discloses all the limitations as describe above. Ballantyne also discloses the server (i.e. Master Library ML) is linked to other medical institutions terminal (i.e. hospitals). It does not explicitly disclose upon receiving medical information reference request from first institution terminal (i.e.

hospital) allow second institution terminal (i.e. other hospital) to access patient information. However it is predictable result that other hospital can access the patient information while they are connected to server. (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

13. In addition, “a reference request step for, upon receiving a medical information reference request from a first medical institution terminal to allow a second medical institution, to which said patient is introduced, to download and view said medical information of said patient, transmitting a content of said medical information reference request to said patient terminal used by said requested patient; a reference permission step for, upon receiving a permission response from said patient terminal to permit said second medical institution to download and view said medical information, transmitting download permission key data to permit said second medical institution to download and view said medical information to said second medical institution terminal ; and a reference execution step for, upon receiving said download permission key data transmitted from said second medical institution terminal, authenticating the validity of said download permission key data and transmitting said medical information to said second medical institution terminal.” is an intended use of information control device. Therefore it has been held that a claim while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on Mon-Thr 7:30am-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./
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/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 4137